

### III. Remarks

*Restriction and Election of Species:* In response to the examiner's indications relative to Office's withdrawal of claim 10, the Assignee has herein indicated, with a claim status label, that claim 10 is indeed withdrawn.

The Examiner presented several concerns regarding the drawings. The Assignee would note that two phone calls were placed to the Examiner, Ernesto Garcia, by the undersigned, one on April 20, 2010 and a second on April 22, 2010, to discuss the best way to resolve the Examiner's concerns. Messages were left after the undersigned was automatically forwarded to the Examiner's supervisor's voicemail (i.e., one Supervisor Daniel Stodola's voicemail), requesting a return call to discuss how best to resolve the examiner's concerns (particularly formality type concerns relative to the drawings, specification and claims). No call back was received, however. The changes and explanations made herein are the Assignee's best effort to resolve the Examiner's concerns.

*Concerns Relative to the Drawings:* In response to the Examiner's concerns relative to the drawings, the Assignee presents the explanations below and the Replacement Drawings, as the Appendix filed herewith, incorporated herein by reference. The Examiner first objected to the drawings as failing to comply with 37 CFR 1.84(p)(4) because reference characters 4 and 21 designate the same apertures. In response, the Assignee indicates that the projections 20 and recesses 21 (see amendments to the specification above, and drawings as amended herein) work cooperatively together to form a type of relative motion obstruction element; clearly, axial and rotation motion of the compression sleeve element relative to the larger elongated tube is prevented only when the projection and the recess interface cooperatively, i.e., the projection enters into the recess. As such, both the projections and the recesses are needed in this type of relative motion obstruction element for undesired relative motion to be prevented.

Additionally, the following passage:

It should be noted that the term element as used in this application may describe not only one part or structure, but also a plurality of parts or structures, e.g., that make up a device. As such, in at least one embodiment of the inventive technology, the relative motion obstruction element may include at least one projection (20) (e.g., a post, which may have any cross-sectional shape and which may project inwardly from the compression sleeve element), and at least one recess (21) (e.g. a hole) sized to receive the post, thereby preventing axial and rotational motion. Of course, a projection may be engaged with a recess upon establishment of the projection in the recess.

page 5, lines 4-12 of the initial filing (emphasis added; said passage as amended hereinabove), makes clear that the relative motion obstruction element, like any element, can have more than part or structure. With the text “...in at least one embodiment of the inventive technology, the relative motion obstruction element may include at least one projection (20)...”, the passage also makes clear that the projection and recess design is not the only type of relative motion obstruction element. However, in the embodiment shown in Figs. 1 and 2, the relative motion obstruction element shown is the projection 20 and the recess (hole, as shown) 21.

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(4) because it appears that reference characters 13 and 14 designate the same longitudinal axis. In response, the Applicant has removed the “first longitudinal axis” from the claims and description, replaced “second longitudinal axis” with “larger elongated member longitudinal axis”, and removed 13 (which referenced the first longitudinal axis from the drawings and specification). Just as, hypothetically, an “adhering element” (i.e., that which causes adhesion of part X to part Y) could be: (a) glue; or (b) a bolt, hole and nut; or (c) a magnet and iron surface, and a figure depicting the bolt, hole and nut embodiment could reference the bolt as being both a bolt and a part of the adhering element, so too can 4 (the relative motion obstruction element) and the 21 (the recess) reference the same component or part.

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(4) because reference character 4 was used to designate both an aperture and a projection. In response, the Assignee would indicate that the following passage from the application:

It should be noted that the term element as used in this application may describe not only one part or structure, but also a plurality of parts or structures, e.g., that make up a device. As such, in at least one embodiment of the inventive technology, the relative motion obstruction element may include at least one projection (20) (e.g., a post, which may have any cross-sectional shape and which may project inwardly from the compression sleeve element), and at least one recess 21 (e.g. a hole) sized to receive the post, thereby preventing axial and rotational motion. Of course, a projection may be engaged with a recess upon establishment of the projection in the recess.

page 5, lines 4-12 of the initial filing (emphasis added; said passage as amended hereinabove), makes clear that the relative motion obstruction element, like any element, can have more than part or structure.

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(4) because reference character 2 was used to designate a compression sleeve element having a first figuration (as shown in Fig. 7) and two compression halves (Fig. 1). In response, the Assignee would explain that Figs. 1 and 7 depict apparatus having two different types of compression sleeve elements. What is shown in the figures are merely two examples of the several different configurations that the “compression sleeve element” may assume. Further, it is clear from the following text:

It should be noted that the term element as used in this application may describe not only one part or structure, but also a plurality of parts or structures, e.g. that make up a device.

page 5, lines 4-6, that an element (such as the “compression sleeve element”) may have more than one part.

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) because reference character 25 was deleted from the specification yet still appears in the drawings. In response, reference numeral 25 has been canceled from Fig. 1. Reference numeral 25 has been added to Fig. 7, where it now refers to a nut into which bolt 24 may be threaded. Components appearing in Fig. 1 as filed are now labeled as 41 and 42; the specification has been amended to identify them as the first pin and second pin, respectively. That they are pins is clear from the drawings (e.g., Figs. 1, 2, 4, 5 and 6); indeed, such pins are well-known features of the known collar described disclosed in the specification. In response to the Examiner's concerns that part referred to as 23 (clearly a bolt) of Fig. 7 does not appear in the description, the Assignee has renumbered such part as 24 and amended the description, including Fig. 7, accordingly.

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(1) because of the presence of a bracket in Fig. 1. In response, the Assignee has removed the bracket of Fig. 1, using only a reference line to point generally to the retention apparatus that it stands for. Other brackets (for components 5 and 7 in Fig. 1; 16 in Fig. 2; and 9 and 10 in Fig. 6) have been removed and replaced with a single arrow. 19 of Fig. 2 has been replaced with a non-arrowed lead line. Unfortunately, without the use of brackets, it is difficult to point out clearly what components are included in those elements (or other limitations) that include more than one component. The lead lines of reference character 17 have been changed to one lead line pointing to the cam. Lead line 13 has been deleted. The incorrect cross-hatching of space in the tube of Fig. 3 has been deleted; the walls of the tubes (first elongated member and larger elongated member) have been cross-hatched. As to the concerns regarding 3 of Fig. 7, the Assignee would indicate that 3 may be made up of several components; nonetheless, Fig. 7 has been amended in accordance with the Office's preferences. As to the concern regarding the "projections" of Fig. 3, the Assignee would point out that the lines don't represent projections, but rather an embodiment of the apparatus in cross-sectional view. The curved represents a contacting portion of the post 20, which, in the embodiment depicted, is rounded to achieve point contact.

#### Concerns Relative to the Specification:

In response to the Office's concerns regarding the description of reference character 21, the Assignee has herein amended the specification to indicate that the 20 is a projection (e.g., a post) and 21 is a recess (e.g., a hole).

#### Claim Objections:

In response to the Examiner's concerns relative to claim 1, the term "itself" in line 12 has been deleted. In response to the Examiner's concerns relative to claim 9, the comma has been inserted after "member" in line 3 and "to said compression sleeve element" has been inserted after "surface" in line 5. Of course, the use of the term between (e.g., "between X and Y") as used in claim 9 does not require that all portions from "X" and "Y" are occupied by the clearance.

#### Claim Rejections (35 USC §112):

The Examiner expressed concern under 35 USC §112 that the claims omitted a necessary cooperative relationship between the "levered clamp" (now a "single clamp") and the compression sleeve element. In response, the Assignee has amended claim 1 as indicated herein to more particularly describe how the two cooperate.

The Examiner expressed concern under 35 USC §112 relative to whether the larger elongated member is part of the retention apparatus. In response, the Assignee has amended claim 1 as indicated herein.

The Examiner expressed concern under 35 USC §112 relative to hole of claim 1 as being part of the "relative motion obstruction element" and the "larger elongated member." In response, the Assignee would point out that claim 1 no longer uses the term "hole" or "recess". Now, because of the amendments made herein, claims 46 and 48 relate the term recess (or hole) to the larger elongated. However, neither does so in a manner that

would render the recess or hole as part of the elongated member. More particularly, claim 46 uses the language: “at least one recess in said larger elongated member”, while claim 48 uses the language “said at least one hole is through said larger elongated member.” Neither text renders the recess or hole as part of the larger elongated member. As the claims now clearly indicate a mutual exclusivity of the recess/hole and the larger elongated member, neither the hole nor the recess is part of both the relative motion obstruction element and the larger elongated member.

The Examiner expressed concern under 35 USC §112 relative to the establishment of the “levered clamp” (now “single clamp”) of claim 1. In response, the Assignee has amended claim 1 as indicated herein. In response to the Examiner’s concerns relative to the use of the term “upon activation”, the Assignee would explain that it is well established that such “functional limitations” are not necessarily improper. Indeed, it has been stated that “there is nothing inherently wrong in defining something by what it does rather than what it is.” *In re Echerd and Watters*, 176 U.S.P.Q. (BNA) 321 (C.C.P.A.1973). *See also*, MPEP 2173.05(g), stating that:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

...

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as “**members adapted to be positioned**” and “portions ... being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

MPEP 2173.05(g), (emphasis added). The Assignee submits that the concerning language (“established...so that, upon activation”) is very similar to the “members adapted to be positioned” limitation that the MPEP recognizes courts view as acceptable.

While the caselaw also recognizes that functional limitations may be overly broad (see, *e.g.*, *In re Fuller*, 388 Off. Gaz. Pat. Office 279, 35 F.2d 62 (C.C.P.A. 1929), where the limitation “A woolen cloth having a tendency to wear rough rather than smooth” was rejected as describing the intended subject matter “too broadly”), the term “established...so that, upon activation” is much more similar to the acceptable “members adapted to be positioned” limitation than it is to the unacceptable “having a tendency to” limitation. Further, the term “upon activation” merely acts to clarify the clearly structural limitation “established around said compression sleeve element.”

In response to the Examiner’s concerns relative to the use of the term “where said third portion of said first elongated member has a first longitudinal axis” of claim 2, the Assignee indicates that the term has been removed from claim 2, and that claim 1 makes clear that the first elongated member is indeed claimed as part of the retention apparatus.

In response to the Examiner’s concerns relative to claim 11, the Assignee indicates that claim 1 now claims the elongated members as part of the retention apparatus.

In response to the Examiner’s concerns relative to claim 13, the Assignee indicates that claim 1 now claims the elongated members as part of the retention apparatus.

In response to the Examiner’s concerns relative to claim 20, the Assignee has amended claim 20 herein. The Assignee indicates that the Examiner’s concerns relative to the use of the term “each directly contact one of said elongated members” has been resolved by the amendment to claim 1 to clarify that the elongated members are claimed, and by the cancellation of such term from claim 20.

In response to the Examiner's concerns relative to claim 21, the Assignee has amended claim 21 herein.

In response to the Examiner's concerns relative to claim 42, the Assignee would indicate that the amendments to claim 1 that clarify that indeed the elongated members are claimed as part of the claim 1 (and claims depending therefrom, such as claim 42) have resolved such concerns.

Concerns relative to claims 3, 4, 8, 9, 12 and 20 due to their dependence from claim 1 have been resolved because of the amendments to claim 1.

Concerns Under 35 USC §102:

The Examiner expressed concerns relative to claims 1, 11 and 21 under 35 USC 102(b) as being anticipated by McConnell (US 4,576,501, referred to hereinafter as McConnell). However, McConnell does not disclose a "single clamp established around said compression sleeve element so that, upon activation of said single clamp, said single clamp forces: said larger elongated member compression surface against said larger elongated member, and said first elongated member compression surface towards a site on said first elongated member" (emphasis added), as claim 1 requires. Indeed, in McConnell, in order to force components compressively against the first elongated member and the larger elongated member, two "clamping adjustments" (as McConnell refers to them) must be activated. Indeed, this is apparent from Figs. 1, 2 and 3 (showing a first embodiment), Figs. 5 and 6 (showing a second embodiment); and Fig. 7 (showing a third embodiment). Clearly, each embodiment requires operation of two rotatable, threaded bolts (see 32 and 54 relative to the first embodiment of McConnell, 96 and 98 relative to the second embodiment of McConnell, and the two hand-turnable threaded bolts of Fig. 7 relative to the third embodiment of McConnell). The Abstract of McConnell makes clear that embodiments provide "two separate and independent clamping adjustments" (see Abstract). Other passages in McConnell (see, e.g., col. 1, lines 5-17; col. 2, lines 9-17; col. 3, lines 13-16; col. 4, lines 3-6; col. 4, lines 45-53; col.



5, lines 5-11; and col. 6, lines 58-64) make clear that all embodiments require operation of two clamping adjustments to force compression surfaces against both tubes. Indeed, the stated advantage of the McConnell invention is to offer vertical adjustment of the telescoping tube that is independent of rotational adjustment of the telescoping tube. However, as indicated above, claim 1 of the instant application requires that activation of only a single clamp will force compression surfaces against both tubes.

The Examiner expressed concerns relative to claims 1-4, 11-13, 21 and 42 under 35 USC 102(b) as being anticipated by Hempel (US 4,397,088, referred to hereinafter as Hempel). However, Hempel, like McConnell, does not disclose “single clamp established around said compression sleeve element so that, upon activation of said single clamp, said single clamp forces: said larger elongated member compression surface against said larger elongated member, and said first elongated member compression surface towards a site on said first elongated member” (emphasis added), as claim 1 requires. First, we make some preliminary observation relative to Hempel: the component(s) most analogous in Hempel to the clamp of claim 1 of the instant application are Hempel’s screws 48; and the component(s) most analogous in Hempel to the elongated members of claim 1 of the instant application are Hempel’s tubes. However, it is readily apparent that in order to force any compression surfaces against both of the tubes in Hempel it is necessary to operate at the least two of Hempel’s screws - one of the two screws 48 towards part 14 and one of the two screws 48 further away from part 14 (see Fig. 1). As such, Hempel does not disclose the limitation: “single clamp established around said compression sleeve element so that, upon activation of said single clamp, said single clamp forces: said larger elongated member compression surface against said larger elongated member, and said first elongated member compression surface towards a site on said first elongated member”, as claim 1 requires.

Concerns Under 35 USC §103:

*Claim 13:* The Examiner expressed obviousness concerns relative to claim 13 as based on McConnell. In response, the Assignee would explain that MPEP 2143 requires that, *inter alia*, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143, Basic Requirements of a *Prima Facie* Case of Obviousness. However, claim 13 depends from claim 1 (and therefore incorporates all the limitations of claim 1), and, as explained above, McConnell does not disclose the limitation : “single clamp established around said compression sleeve element so that, upon activation of said single clamp, said single clamp forces: said larger elongated member compression surface against said larger elongated member, and said first elongated member compression surface towards a site on said first elongated member” (emphasis added). As such, the requirement for a *prima facie* case of obviousness has not been met; the Assignee respectfully requests that the McConnell based obviousness concerns relative to claim 13 be withdrawn.

*Claim 8:* The Examiner expressed obviousness concerns relative to claim 8 as based on Hempel and US Patent No. 6,557,878 (hereinafter referred to as “Chen”). In response, the Assignee would explain that MPEP 2143 requires that, *inter alia*, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143, Basic Requirements of a *Prima Facie* Case of Obviousness. However, claim 8 depends from claim 1 (and therefore incorporates all the limitations of claim 1), and, as explained above, Hempel does not disclose the limitation : “single clamp established around said compression sleeve element so that, upon activation of said single clamp, said single clamp forces: said larger elongated member compression surface against said larger elongated member, and said first elongated member compression surface towards a site on said first elongated member” (emphasis added). However, Chen, as is clear from any of its figures, also does not disclose this limitation. As such, the requirement for a *prima facie* case of obviousness has not been met; the Assignee respectfully requests that the Hempel and Chen based obviousness concerns relative to claim 8 be withdrawn.

#### IV. Conclusion

In response to the Examiner's concerns, the Applicant has amended the claims and the specification. Claims 1, 2, 3, 8, 9, 10, 12, 20, 23, 30, 31, 42 have been amended herein, new claims 43-49 have been added herein, and claims 4 and 21 have been canceled herein. It is believed that all pending claims are in condition for allowance. It is requested that the Examiner please amend the claims as indicated herein, reconsider the application and allow the claims at his earliest convenience.

Dated this 30<sup>th</sup> day of April, 2010.

Respectfully Submitted:

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## **Appendix A**

### **Replacement Drawing Sheets**